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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/804,625 | 03/09/2001 | Elizabeth A. Wang | 5160C-CON | 2656 |

22852 7590 05/17/2005

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EXAMINER

ROMEIO, DAVID S

ART UNIT PAPER NUMBER

1647

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|------------------------------------|--|
| Office Action Summary | Application No. 09/804,625 | Applicant(s) WANG ET AL. | |
| | Examiner David S. Romeo | Art Unit 1647 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 February 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 24-26, 29, 30, 33, 35, 36, 38, 39, 41 and 42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 26, 30 and 41 is/are allowed.
- 6) Claim(s) 24, 25, 29, 33, 35, 36, 38, 39 and 42 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>0305</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1647

DETAILED ACTION

The amendment filed 02/22/2005 has been entered. Claims 24-26, 29, 30, 33, 35, 36, 38, 39, 41, 42 are pending and being examined.

5 **Maintained Formal Matters, Objections, and/or Rejections:**

Priority

A polynucleotide comprising nucleotides 1202-1543 of Figure 2 or comprising nucleotides encoding amino acids 283 through 396 of Figure 2 was first disclosed in the manner provided by 35 U.S.C. 112, first paragraph, in U. S. Application No. 07/721,847 (filed 10 06/14/1991). Accordingly, the effective filing date of the present claims that are directed to or encompass these embodiments is 06/14/1991.

Applicants argue that the present application claims priority to U. S. Patent No. 5,013,649, filed April 8, 1988, which discloses the same sequence as figure 2 of the present application, and therefore the present claims are entitled to the April 8, 1988 filing date. 15 Applicant's arguments have been fully considered but they are not persuasive. There is no disclosure of the 1202-1543 or 283-396 subsequences of figure 2 prior to U. S. Application No. 07/721,847, filed 06/14/1991. Hence, these subsequences are new matter with respect to any prior application filed before U. S. Application No. 07/721,847 and are not disclosed in the manner provided by 35 U.S.C. 112, first paragraph, in the applications filed before 06/14/1991.

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Claim Rejections - 35 USC § 102

Claims 24, 25, 29, 33, 35, 36, 38, 39, 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Wozney (U).

In addition, support for the hybridization conditions (claim 33) cannot be found in the disclosure as originally filed, which raises the new matter. Accordingly, the effective filing date of the claims that are directed to or encompass these hybridization conditions is the filing date of the present application.

Applicants argue that the pending claims are entitled to the April 8, 1988 filing date. Applicant's arguments have been fully considered but they are not persuasive. There is no disclosure of the 1202-1543 or 283-396 subsequences of figure 2 prior to U. S. Application No. 07/721,847, filed 06/14/1991. Hence, these subsequences are new matter with respect to any prior application filed before U. S. Application No. 07/721,847 and are not disclosed in the manner provided by 35 U.S.C. 112, first paragraph, in the applications filed before 06/14/1991.

15 ***New Formal Matters, Objections, and/or Rejections:***

Claim Rejections - 35 USC § 112

Claims 33, 36, 39, 42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Support for the hybridization conditions (claim 33) cannot be found in the disclosure as originally filed, which raises the new matter.

Conclusion

Claims 26, 30, 41 are allowable.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

5 Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

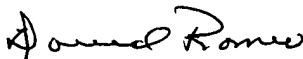
15 ANY INQUIRY CONCERNING THIS COMMUNICATION OR EARLIER COMMUNICATIONS FROM THE EXAMINER SHOULD BE DIRECTED TO DAVID S. ROMEO WHOSE TELEPHONE NUMBER IS (571) 272-0890. THE EXAMINER CAN NORMALLY BE REACHED ON MONDAY THROUGH FRIDAY FROM 7:30 A.M. TO 4:00 P.M. IF ATTEMPTS TO REACH THE EXAMINER BY TELEPHONE ARE UNSUCCESSFUL, THE EXAMINER'S SUPERVISOR, BRENDA BRUMBACK, CAN BE REACHED ON (571) 272-0961.

20 IF SUBMITTING OFFICIAL CORRESPONDENCE BY FAX, APPLICANTS ARE ENCOURAGED TO SUBMIT OFFICIAL CORRESPONDENCE TO THE CENTRAL FAX NUMBER FOR OFFICIAL CORRESPONDENCE, WHICH IS (571) 273-8300.

CUSTOMERS ARE ALSO ADVISED TO USE CERTIFICATE OF FACSIMILE PROCEDURES WHEN SUBMITTING A REPLY TO A NON-FINAL OR FINAL OFFICE ACTION BY FACSIMILE (SEE 37 CFR 1.6 AND 1.8).

FAXED DRAFT OR INFORMAL COMMUNICATIONS SHOULD BE DIRECTED TO THE EXAMINER AT (571) 273-0890.

25 ANY INQUIRY OF A GENERAL NATURE OR RELATING TO THE STATUS OF THIS APPLICATION OR PROCEEDING SHOULD BE DIRECTED TO THE GROUP RECEPTIONIST WHOSE TELEPHONE NUMBER IS (703) 308-0196.

30 

DAVID ROMEO
PRIMARY EXAMINER
ART UNIT 1647